

**REMARKS**

This response is submitted in response to the Final Office Action mailed July 16, 2003, to request reconsideration of the rejection of claims 1-20 as set forth therein.

In the Official Action, the Examiner rejects claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,049,823 to Hwang (hereinafter "Hwang") in view of U.S. Patent No. 6,173,279 to Levin et al. (hereinafter "Levin").

In response, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Firstly, the Applicant respectfully submits that the combination of the Hwang and Levin references do not show all of the features of the independent claims (1, 7, 12, 19, and 20). Secondly, the Applicant submits that even if all of the features of the claims are shown in the combination of Hwang and Levin, there is no motivation or suggestion for their combination. Thirdly, the Applicant submits that at least the Levin reference is from a non-analogous art.

With regard to the first argument, the Applicant submits that not all of the features of the claims are shown in the combination of the Hwang and Levin references and therefore, the Examiner has failed to make a prima facie showing of obviousness.

Hwang discloses an interactive television system for hotels where a plurality of televisions are interconnected. The televisions in the system can be used to watch private channels (private viewing). Each television in the system can also interact with another television in the system (group viewing), such as playing a horse racing game or participating in a shopping tour (column 16, lines 53-59). Each television in the system can access every group and private channel through a set-top box provided with each television.

Levin discloses a system that uses a natural language interface to retrieve information from a data source. Thus, for example, if a user desires a telephone number of an establishment, he or she would go to a data source, such as a particular web site, and make a textual or spoken query for the telephone number. For example, the query may be "call the pizza place on Main Street in Westfield." From this query, the system retrieves the information from the data source and the action performed (i.e., the call is made).

Claim 1 recites:

"a processor configured to provide query information requesting information identifying at least one of content and channel currently watched on the other television and configured to automatically provide queried information identifying at least one of content and channel currently watched at said television in response to a query request from the other television."

Applicants respectfully submit that neither Hwang nor Levin disclose such features. Hwang does not teach the televisions querying any other televisions in the system for any type of information. Hwang merely teaches an interconnected network of televisions adapted for interactive operation with each other. Levin does not cure this deficiency in Hwang. Levin teaches making a natural language query from a telephone to a data store (e.g., a website). The query of Levin is not between interconnected televisions, is not for information relating to the device, and does not relate to one of content and channel currently watched.

Thus, claim 1 patentably distinguishes over the combination of Hwang and Levin and is allowable. Claims 7, 12, 19, and 20 contain similar recitations and are allowable for the same reasons as set forth above with regard to claim 1.

Independent claims 1, 7, 12, 19, and 20 are not rendered obvious by the cited references because neither the Hwang patent nor the Levin patent, whether taken alone or in

combination, teach or suggest a television, communication system, or method having the features described above. Accordingly, claims 1, 7, 12, 19, and 20 patentably distinguish over the prior art and are allowable. Claims 2-6, 8-11, and 13-18 being dependent upon claims 1, 7, and 12, are at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-20 under 35 U.S.C. § 103(a).

Secondly, assuming *arguendo* that the features of the claims are shown in the combination of references, the Applicant further submits that there is no motivation or suggestion to combine the references and thus, the combination is improper and must be withdrawn.

Recently, the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) (*In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Instead, the Board merely invoked the high level of skill in the field of the art. If such a rote indication could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields, the Board could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for rejection. To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

*In re Rouffet*, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

*In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them. This the Examiner has not done. The Examiner only states that it would be obvious "to one of ordinary skill in the art at the time of the invention was made to modify Hwang's television-to-television interactive system with Levin's teaching technique in using query information as means for communicating between PCs or PC-televitions, it is well known in the art that a PC can be incorporated into a TV as a PCTV for handling television and PC functions, as long as there is a request for that queried information initiated by one of the interactive television users as desired." (see page 3 of the Final Official Action). *In re Rouffet* and *In re Dembiczak* make it clear that this alone is not enough.

However, there is no teaching or suggestion in Hwang that the televisions in the system query each other for any type of information, and certainly not for information relating to the device, such as the content and/or channel being watched on the device. Therefore, those skilled in the art would not be motivated to look to Levin for teaching the querying of a device (or any reference teaching a query). Thus, the link between the Hwang and Levin teachings could have only be gleaned from the present application itself, which is improper.

Therefore, the Applicant respectfully submits that the Examiner, without identifying a suggestion, motivation, or teaching for combining the references, has used impermissible hindsight to reject claims 1-20 under 35 U.S.C. 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejections for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

Thirdly, Applicant respectfully submits that at least the Levin reference is not proper because it is from a non-analogous art. To be considered analogous art, the references cited by the Examiner must be either in the same field as the invention or be reasonably

pertinent to the problem faced by the inventor.<sup>1</sup> Applicant respectfully submits that neither of these requirements have been met in the present case.

With regard to the first prong of the non-analogous art test -- namely, whether a reference is within the field of the invention, the Federal Circuit has stated:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances" -in other words, common sense- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.<sup>2</sup>

Thus, a case-by-case analysis must be made to determine if a person of ordinary skill would look to the fields of the references for a solution to the problem facing the inventor.<sup>3</sup>

In clarifying how to determine the second prong of the test -- namely, whether a reference is reasonably pertinent to the particular problem with which an inventor was involved, the Federal Circuit has stated that:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem ... If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem ... [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.<sup>4</sup>

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<sup>1</sup> See, e.g., *In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058 (Fed. Cir. 1992); *In re Paulsen*, 30 F.3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994); and *Wang Labs., Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ 2d 1767 (Fed. Cir. 1993).

<sup>2</sup> *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992).

<sup>3</sup> Id. See also, *In re Wright*, 848 F.2d 1216, 6 USPQ 2d 1959, 1962 (Fed. Cir. 1988) ("[A]s with all section 103 decisions, judgement must be brought to bear based on the facts of each case.").

<sup>4</sup> *In re Clay*, 23 USPQ 2d at 1060-1061.

With regard to the first prong of the non-analogous art test, and in view of the Federal Circuit's narrow view of what is in the same field of endeavor,<sup>5</sup> it cannot be said that the Levin reference is within the same field of endeavor as the present invention, which is directed to a television and communication system comprising a plurality of interconnected televisions. The Levin reference is not remotely related to such devices. If memory circuits are not considered in the same field of endeavor as compact modular memories, as held by the Federal Circuit in the *Wang* case<sup>6</sup>, then the Levin reference cannot be considered to be in the same field of endeavor as a television or communication system comprising a plurality of interconnected televisions. As discussed above, Levin is directed to querying a data source with natural language. Thus, Applicant respectfully submits that at least the Levin reference is not in the same field of endeavor as the present invention.

With regard to the second prong of the non-analogous test, Applicant respectfully submits that the Levin reference is not reasonably pertinent to the particular problem with which the inventor of the present invention was involved.

As discussed above and at length in the specification, the present invention is directed to the problem of knowing what others, for example children, are watching on another television, which may be in the same household or remotely located. This is a very different problem than faced by the inventors of the Levin reference. In Levin, the inventors were faced with the problem of overcoming shortcomings in the prior art of making queries

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<sup>5</sup> In *Wang Laboratories*, 26 USPQ 2d 1767, in which the present invention related to memory circuits and the cited reference referred to compact modular memories, the Federal Circuit held that the cited references were not in the same field of endeavor, stating that the reference "... is not in the same field of endeavor as the claimed subject matter merely because it relates to memories."

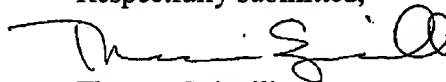
<sup>6</sup> Id.

for information from databases. Thus, Levin was not faced with the same problem as was the inventor of the present invention. To paraphrase the words of the Federal Circuit, the matter with which the Levin reference deals, logically would not have commended itself to the inventor's attention in considering his problem. Thus, since it is directed to different purposes, the inventor would accordingly have had no motivation or occasion to consider it.

Accordingly, Applicant respectfully submits that at least the Levin reference is not in the same field of endeavor as the present invention, nor is it reasonably pertinent to the particular problem with which the inventor of the present invention was involved. Consequently, the Examiner is respectfully requested to withdraw the cited references, thereby rendering the 35 U.S.C. § 103(a) rejections of claims 1-20 moot.

The above amendments and remarks establish the patentable nature of all the claims currently in this case. Issuance of a Notice of Allowance and passage to issue of these claims are therefore respectfully solicited. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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